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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,479	12/17/2001	Domingo Rohde	81,485/LPK	2759

7590 05/25/2004

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EXAMINER

NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 05/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/022,479

Applicant(s)

ROHDE ET AL.

Examiner

Janis L. Dote

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment, paragraphs 1 and 2.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment, paragraph 3.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 12, 14 and 17-20.

Claim(s) withdrawn from consideration: 1-11.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☒ Other: attachment

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP 1700
1700

1. The proposed "amendment to the claims" filed in the amendment filed after the final rejection on May 7, 2004 (Amdt050704), is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, Jun. 30, 2003). Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified. In particular, claims 1-11 have been identified as "Previously Withdrawn," which is not permitted under 37 CFR 1.121. The claims should be identified with the permitted status identifier "Withdrawn." Claims 14, 17, 18, and 20 are labeled "Previously Amended," not with the permitted status identifier "Previously presented." Claims 13, 15, 16, 21, and 22 are labeled "Previously Cancelled," not with the permitted status identifier "Cancelled."

37 CFR 1.121(c) states that "the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), Cancelled), (Withdrawn), Previously presented) . . . "

In addition, the proposed amendment also includes the text of cancelled claims 13, 15, 16, 21, and 22, which is not permitted under 37 CFR 1.121.

37 CFR 1.121(c)(4)(i) states that "[n]o text shall be presented for any claim in the claim listing with the status of 'cancelled' or 'not entered.'"

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2. The proposed amendment to the specification raises the issue of new matter under 35 USC 132. There is no disclosure in the specification that recognizes that it is "well-known in the toner industry that '%' bases of compositions is 'by weight'" as stated in the amendment. Nor does the specification recognize the fact that "since the specific gravities are similar here, the bases can be either 'weight' or 'volume'" as stated in the amendment.

The proposed amendment to claim 12 raises numerous rejections under 35 USC 112, second paragraph. The following examples are not exhaustive. For example, the claim limitation "toners in a toner layer have absorption properties . . . so as to absorb less than 10% of the energy" is indefinite because it is not clear to what the toners in a toner layer are being compared. The claim limitation "[t]oners, for a color printer and/or copier device, where a toner layer, having different color pigmented particles, is suitable to produce the color or black . . . characterized in that, the toners in a toner layer have absorption properties . . ." is indefinite because it is not clear whether the different color pigmented particles refer to the toners for a color printer and/or copier device. Nor is it clear whether the toner layer in the phrase "toners in a

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toner layer" having absorption properties refers to the toner layer having different color pigmented particles.

In addition, the proposed claim limitation "toners in a toner layer have absorption properties . . . so as to absorb less than 10% of the energy to produce colors or black" (emphasis added) raises a rejection 35 USC 112, first paragraph, for lack of adequate written description. The originally filed specification discloses that the toner that is suitable to produce the color black, which "has similar absorption properties . . . as other customary toners that are provided to produce colors other than black," "absorbs less than 10% of the energy when it is irradiated with electromagnetic radiation with a wavelength in the IR range below approximately 5 μm ." See the originally filed specification, page 6, lines 14-19, and page 7, lines 5-8. In other words, the specification discloses that a toner that is suitable to produce the color black has an absorption that is similar to the absorption of other toners that produce colors other than black; and that said absorption is preferably less than 10% of the energy of the other toners when the toner that produces the color black is irradiated with electromagnetic radiation with a wavelength in the IR range of below approximately 5 μm . The specification does not disclose that "toners in a toner layer . . . absorb less than 10% of the

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energy to produce colors" (emphasis added) as recited in the proposed amendment to claim 12.

3. The examiner's refusal to enter the amendment filed after the final rejection in Amdt050704 renders moot applicants' arguments regarding the amendment to the specification, the amendment to claim 12, and the amended drawing of Fig. 1. According, the objections to the specification and the drawings and the rejections of claims 12, 14, and 17-20 stand.